



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 03226/795001; SUN060205	
	Application Number 09/845,457-Conf. #3019	Filed April 30, 2001	
	First Named Inventor Jonathan Casey Salas et al..		
	Art Unit 2154	Examiner M.A. Siddiqi	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,479</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p><u>TSF-A45,079</u> Signature</p> <p><u>Robert P. Lord</u> Typed or printed name <u>THOMAS SCOTTESR</u></p> <p><u>(713) 228-8600</u> Telephone number</p> <p><u>October 10, 2006</u> Date</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Jonathan Casey Salas et al.

Application No.: 09/845,457

Confirmation No.: 3019

Filed: April 30, 2001

Art Unit: 2154

For: **MANAGING USER ACCESS OF  
DISTRIBUTED RESOURCES ON  
APPLICATION SERVERS**

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Examiner: M. A. Siddiqi

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Rejections under 35 U.S.C. § 112**

Claim 1 stands rejected under 35 U.S.C. § 112, paragraph 2, for failing to point out and distinctly claim the subject matter which the applicant regards as his invention. Specifically, claim 1 was rejected for purportedly reciting an apparatus and method *using* the apparatus in a single claim. In support of the rejection, the Examiner has cited *Ex Parte Lyell*, 17 U.S.P.Q 2d 1548 (BPAI 1990).

Briefly, *Lyell* holds that “a single claim which claims both an apparatus and the method steps of *using* the apparatus is indefinite under 35 U.S.C. 112, second paragraph.” (See MPEP §2173.05(p) (II)) (emphasis added). Applicant asserts that *Lyell* is not applicable to the claims of the present invention.

In the present application, the claims are directed to a new apparatus for permitting a user to access a resource using a token. The new apparatus includes a database, a license manager

configured to use the data in the database to generate a token for the user, and a token manager configured to initiate and/or terminate access to a resource based on the token.

In defining the licensing manager, functional steps are used. These steps, recited in claim 1, are present to describe limitations of a single component (*i.e.*, the license manager) *of* the apparatus. In contrast, the holding of *Lyell* is directed to the scenario in which the claims recite an apparatus and a method for *using the apparatus* and, thus, is not applicable to the claims of the present application. Said another way, the holding in *Lyell* is only applicable to claims that recite an apparatus and method, where the method describes the use of the apparatus *as a whole*; *Lyell* is not applicable to elements of a claim, which happen to recite steps in an effort to describe limitations of a given component *of* the apparatus. Clearly, describing a component using steps is not equivalent to defining a method of using the apparatus of which the component is a part.

In view of the above, the Examiner has clearly misconstrued and misapplied the holding of *Lyell* to reject the present claims. Accordingly, a favorable decision from the panel is respectfully requested.

### **Rejections under 35 U.S.C. § 102**

#### Legal Standard for Establishing Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131).

Arguments

Claims 1, 5-11, 14-17, and 19-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,918,113 (“Patel”). Patel fails to disclose all of the claimed limitations in the pending claims.

A. *Patel Fails to Disclose a Token as Recited in the Independent Claims*

As recited in independent claims 1 and 11, two sub-tokens (*i.e.*, the first sub-token and the second sub-token) are created for the same user. Specifically, each of the aforementioned sub-tokens, as recited in the independent claims, is created using a policy instance (*i.e.*, a first policy instance and a second policy instance), where each of the aforementioned policy instances is associated with the *same* user. Once the sub-tokens are created, the sub-tokens are combined to produce a token, where the token allows the user to access a resource. Thus, the token is a combination of at least two sub-tokens, each of which is created for the same user and each of which must be valid in order to allow the user to access the resource. (*See e.g.*, Instant Application, pp. 9-10).

Turning to Patel, Patel discloses issuing a *single* access token for a given user to access a resource, where the single access token is not generated using two or more sub-tokens created for the user (*see* Patel, col. 10, ll. 33-52). Rather, the single token in Patel is merely a token that indicates whether the user presenting the token has a valid license. Further, the Examiner is erroneously equating the “expiry time” disclosed in Patel to a sub-token (*see* Office Action mailed July 7, 2006, p. 9-10) which explicitly readouts an express limitation of the independent claims. Specifically, the claims require two sub-tokens to be combined to produce a single token. In contrast, the expiry time is merely a field associated with the single token disclosed in Patel and is not a sub-token (*see* Patel,

col. 10, 33-52). Therefore, the “expiry time,” as taught by Patel, cannot be considered to read on the two sub-tokens recited in the claims without the Examiner improperly reading the claims overly broad or mischaracterizing the invention.

B. Patel Fails to Disclose the Functionality of the License Manager Recited in the Independent Claims

Aside from disclosing that an access token is generated if there is a valid license agreement and that the access token includes an expiration time (*see* Patel, col. 10, ll. 33-52), Patel does not disclose a license manager that is configured to create a token as recited in the claims. In fact, Patel is completely silent with respect to generating a token using license policy types, policy instances, and sub-tokens. Further, Patel is completely silent with respect to managing access to the resource using the sub-tokens.

C. Patel Fails to Disclose a Token Monitor that Monitors a Sub-token as Recited in Dependent Claims 5-8

As discussed above with respect to claim 1, Patel fails to disclose the generation of sub-tokens. Thus, logically, Patel cannot disclose a token monitor that monitors a sub-token. Said another way, Patel merely discloses a single token and monitoring the token as a whole to ensure that the token continues to satisfy all of the license requirements. In contrast, as recited in the dependent claims, the token monitor does not monitor the token in its entirety; rather, the token monitor monitors each sub-token (*e.g.*, the first sub-token) individually. Patel fails to disclose monitoring at the granularity recited in the claims.

D. Patel Fails to Disclose “notifying the user when the first sub-token expires” as Recited in Claim 17

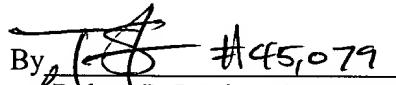
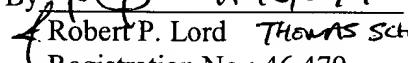
Dependent claim 17 requires that the user is notified once the first sub-token expires (*i.e.*, after the first-sub-token expires). As discussed above, Patel does not disclose monitoring at the sub-token level. Moreover, even assuming *arguendo* that Patel does describe this level of granularity, Patel fails to disclose the issuance of any notification of token expiration *after* the expiration of token. In contrast to the Examiner’s assertion, Patel only discloses notifying the user of an expiry time *prior* to the expiration of the token. (*See* Patel, col. 9, ll. 1-9).

E. The Examiner Has Clearly Failed to satisfy the Requirements Set Forth in MPEP § 2131.

In view of the above, the Examiner has clearly failed to satisfy the requirements set forth in MPEP § 2131 with respect to the pending claims. Accordingly, a favorable decision from the panel is respectfully requested.

Dated: October 10, 2006

Respectfully submitted,

By   
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